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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,689	06/27/2003	Antony Bigot	DEAV20020059USNP	8283

5487 7590 09/26/2006

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EXAMINER

BERCH, MARK L

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/608,689

Applicant(s)

BIGOT ET AL.

Examiner

Mark L. Berch

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

This action is supplemental to the previous office action. The response due date is from the mailing date of this action, not the previous one. All aspects of the previous action are incorporated into this action, except for the rejection of Claims 6-7 over WO 99/22450, which is replaced by the rejections below over 6407076. In addition, the following rejections are made:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by 6407076.

See formula II and Formula IX. Intermediates 5, 19, 24 and 25 anticipate for D=Cl, T = trifluoromethoxymethyl or trifluoroethoxymethyl or 3-F-propoxymethyl, A, B = acetoxy or are combined as seen in Formula IX. Since T is not halomethyl, the first proviso is avoided. Since A,B are not OH, the other provisos are avoided.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by 6407076.

See example 3. This corresponds to T =trifluoromethoxymethyl, A, B =OH, X=C7 cycloalkyl, with Y=H. This avoids all provisos; note that the first only bars C6 cycloalkyl groups.

Claims 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by 6455510.

See formula II and Formula VIII. See species at column 14 lines 31-32. This corresponds to T =trifluoromethyl, A, B =acetoxy, D=Cl. See species at column 17 lines

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49-50. This corresponds to T = difluoroethyl, A, B = acetoxy D=Cl. Formula VIII anticipates the first species of claim 8; Note the definition of P4 and P5 at column 10, line 24. Since T is not halomethyl, the first proviso is avoided. Since A,B are not OH, the other provisos are avoided.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by 6455510.

See example 5. This corresponds to T =difluoroethyl, A, B =OH, X=C7 cycloalkyl, with Y=H. This avoids all provisos; note that the first only bars C6 cycloalkyl groups. Likewise example 11 with T = F-methyl

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over 6407076.

See the species intermediate 19. This differs from the third from last claim 8 species in that claim 8 has trifluoromethoxymethyl while intermediate 19 has trifluoroethoxymethyl. However, the equivalence of these two is taught in the R3 definition (see formula IX), and species 5 and 6 specifically exemplify the trifluoromethoxymethyl choice.

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over 4755594.

See Formula II. The species at column 16, lines 24-25 corresponds to D=Cl, T = chloromethyl A = OR', B = OR'', where R' and R'' are combined to give choice 4, where Rd


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and Re are both methyl. The first proviso excludes this. However, it would render obvious the corresponding 6-F species and thus avoid the proviso. Note that the 6-position is taught as being halogen. Hence, claim 6 is obvious. Claims 7-8 have a second difference, in that prior art compound has T = chloromethyl rather than F-methyl. This is an obvious variation; note that Q can be halogen.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Berch whose telephone number is 571-272-0663. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on (571)272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Mark L. Berch
Primary Examiner
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9/19/2006